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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/790,348 | 03/01/2004 | Bjorn O. Svartz | 15-690 D1 | 9383 |
| 7590 | 10/29/2004 | | EXAMINER | |
| Watts Hoffmann Co., L.P.A. P.O. Box 99839 Cleveland, OH 44199-0839 | | | ENGLISH, PETER C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3616 | |

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/790,348 | SVARTZ ET AL. |
| | Examiner Peter C. English | Art Unit 3616 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 15-28 is/are pending in the application.
 - 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 17-28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 March 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>20040712</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 15-16, drawn to a suspension with a control valve and linkage, classified in class 280, subclass 6.159.
 - II. Claims 17-28, drawn to a trailing arm suspension with a specially-positioned spring, classified in class 280, subclass 124.116.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I has separate utility such as in a vehicle that is not equipped with a height control valve, and Invention II has separate utility such as in any suspension in which height control is desired. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Jennifer Hinton on 26 October 2004 a provisional election was made without traverse to prosecute the invention of Invention II, claims 17-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15 and 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

6. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) and 120 as follows: An application in which the benefit of earlier applications is desired must contain a specific reference to the prior applications in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

Oath/Declaration

7. The declaration is defective for the following reasons:

The declaration does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

The declaration does not clearly identify the city and state of residence of the second named inventor (i.e., Darris L. White). On page 3 of the declaration one residence is given, while on the "attachment" to the declaration a second residence is given. The correct residence information may be provided on either on an application data sheet or supplemental oath or declaration.

A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

Drawings

8. The drawings are objected to because:

In Fig. 2, the lower occurrence of "40b" should be changed to "40a" (see Fig. 3; page 6, line 35).

In Fig. 2, "112a" should be changed to "113" (see Fig. 10; page 11, line 15).

9. Corrected replacement drawing sheets are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

10. The disclosure is objected to because of the following informalities:

At page 2, line 5, "it" should be "is".

At page 2, line 28, "plate within" should be "plates within";

At page 4, line 24, "10, with" should be "10 in Figure 1, with".

At page 6, line 10, "movement in" should be "movement of".

At page 6, line 21, "41" should be inserted after "housing".

At page 6, line 24, "a" should be "the".

At page 6, line 33, "housing" should be inserted after "axle".

At page 7, line 28, "of the axle housing" should be deleted.

At page 8, line 1, "reduce" should be "reduced".

At page 11, line 1, "mount" should be inserted after "pivot".

At page 11, line 22, "4" should be "7".

At page 12, line 13, "94a" should be "96a".

At page 12, line 19, "94a" should be "98a".

At page 12, line 19, "94" should be "98".

At page 12, line 27, "98a" should be "98a, 113, 105".

At page 13, line 26, "the bore 113 of the spacer" should be "the bores 113, 96a of the mounting block".

At page 13, line 27, "bore" should be "bores".

At page 18, line 31, "with" should be "without".

In the abstract, at line 6, "that in" should be "that is".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

11. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 26, at line 1, "said frame member" lacks proper antecedent basis. The examiner suggests: at line 1, change "23" to "25".

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 17, 19, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Raidel '923 (US 4,763,923). Raidel '923 discloses a suspension comprising: a hanger bracket 26 secured to a frame rail 22; a trailing arm 30 pivotally attached to the hanger bracket 26; an air spring 32 extending between the frame rail 22 and the trailing arm 30; and an axle 24 attached to the trailing arm 30. As shown in Figs. 2 and 4, the centerline of the air spring 32 is located slightly to the outside of the frame rail 22. This meets with applicant's definition (see page 15, lines 15-18 of the specification) of a spring centerline that is substantially aligned with a frame rail sheer center.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 18 and 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raidel '923 (US 4,763,923) in view of Sweet et al. (US 4,033,608). Raidel '923 (discussed above) lacks an air spring having a portion located inside a periphery of a wheel. Sweet et al. teaches an air spring 24 having a portion located inside a periphery of a wheel 28 (see Fig. 4). From this teaching of Sweet et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Raidel '923 by locating the air spring such that a portion of the air spring is disposed inside a periphery of a wheel because this enables the wheel well to accommodate lateral expansion of the air spring (see Sweet et al., column 2, line 68 to column 3, line 6), and because this provides for increased stability by maximizing the width of the frame and suspension.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pierce and Cadden teach suspensions having air springs whose centerlines are located slightly to the outside of frame rails.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter C. English whose telephone number is 703-308-1877. The examiner can normally be reached on Monday through Thursday (7:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul N. Dickson can be reached on 703-308-2089. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peter C. English
Primary Examiner
Art Unit 3616

10/26/04

pe
26 October 2004